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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,163	03/04/2002	Kathleen Hickey Wallis	530057-332	6026

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EXAMINER

MOHANDESI, JILA M

ART UNIT PAPER NUMBER

3728

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,163

Applicant(s)

WALLIS, KATHLEEN HICKEY

Examiner

Jila M. Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 16-24, 39, 41, 43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16-24, 39, 41, 43 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14, 16-24, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanco (5,839,575) in view of Farrell (5,464,253). Blanco '575 discloses a fold open display box (10) for displaying an object (booklet 80, floppy disk 84, compact disk 82) and having a planar face, the box comprising: a first section having a first cavity, said first cavity having a cutout portion in a planar face panel; an at least partially transparent window attached over the cut out portion of the first cavity; a second panel section having a second cavity; wherein at least one of the first and second cavities is designed to receive a toy; a toy (booklet) placed in at least one of the first and second cavities that is displayed through the at least partially transparent window (viewing window 86), a wall (binding member 14) connecting said first section to said second section; wherein said wall is connected by a first hinge to the first section. See Figure 2 embodiment and column 2, lines 58-63. Blanco '575 is silent about the material of the booklet. Farrell '253 discloses that it is desirable to make booklets from pressable material to provide a delightful animation in the form of a squirt of water related to the story. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the booklet of Blanco '575 from a

pressable material as taught by Farrell '253 to provide a delightful animation in the form of a squirt of water related to the story. The squirt nozzle (9) will inherently generate a sound when ejecting the water.

With respect to the size of the foldable case, it would have been an obvious matter of design choice to modify the shape and size of the foldable case to accommodate varying size cassettes since video cassettes come in a variety of sizes, since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With respect to the location and number of the cutout portion with a transparent window, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide additional cutout portions with transparent windows in different parts of the foldable case to better view the contents of the foldable case, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

With respect to claim 22 and 41 and the shape of the cut out portion, it would have been an obvious matter of design choice to modify the shape of the cut out in the foldable case to match the items being held therein, since such a modification would have involved a mere change in the shape of a component. A change in the shape is

generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

The fold open display box of Blanco '575 is for storing a compact disks, floppy disks and a booklet. The compact disks can include any type of software including children's games and stories and the book can have material related to the software.

The compact disk containing games and the book having related information for the game can be considered a toy. Therefore the fold open display box of Blanco '575 will contain a toy depending on the software and the associated book. Furthermore a book can be construed as a toy since it can entertain and amuse a child.

3. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 14 above and further in view of Leverence (2,619,168). Blanco '575 as described above discloses all the limitations of the claims except for the transparent window being a meshed screen. Leverence '168 discloses that it is desirable to provide a mesh screen to a window opening to permit ventilation without the admission there into of unwanted objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a mesh screen to the window opening of Blanco '575 as taught by Leverence '168 to allow ventilation without the admission there into of unwanted objects into the foldable case.

4. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 14 above and further in view of Paige (3,641,684). Blanco '575 as described above discloses all the limitations of the claims except for the

box including a loudspeaker for generating sound related to a toy in the box. Paige '684 discloses a box having a loudspeaker for generating sound related to a toy (book and cassette) in the box. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a loudspeaker in the box of Blanco '575 as taught by Paige '684 to generate sound related to a toy (book and cassette) in the box.

Response to Arguments

5. Applicant's arguments filed June 17, 2005 have been fully considered but they are not persuasive. Contrary to applicant's arguments the fold open display box of Blanco '575 does contain a toy since a compact disk is capable of containing a software for a game and a book can be construed as a toy since it can entertain a child.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

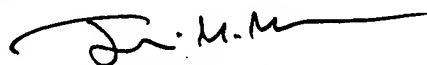
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is ~~703-872-9306~~ **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI
PRIMARY EXAMINER**



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
August 22, 2005